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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,711	11/12/2003	Guillaume Cassin	LOREAL 3.0-046; OA02360/E	9477
530 7590 01/08/2009 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER FUBARA, BLESSING M	
			ART UNIT 1618	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/706,711	<b>Applicant(s)</b> CASSIN, GUILLAUME	
	<b>Examiner</b> BLESSING M. FUBARA	<b>Art Unit</b> 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,8-23,25-35 and 37-46 is/are pending in the application.
- 4a) Of the above claim(s) 3-5 and 14-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,8-13,23,25-35 and 37-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Examiner acknowledges receipt request for extension of time, request for continued examination under 37 CFR 1.114, amendment and remarks filed 10/10/08. Claims 2, 6 and 7 are canceled. Claims 1, 8 and 33 are amended. Claims 1, 3-5, 8-23, 25-35 and 37-46 are pending and of these, claims 3-5 and 14-22 are withdrawn from consideration.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/10/08 has been entered.

#### ***Response to Arguments***

**Previous rejections that are not reiterated herein are withdrawn.**

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 8-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 8 recites 2-acrylamido-2-methylpropane sulfonic acid (AMPS) derivatives and the boundaries of the AMPS derivatives is not defined.

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Applicant may recite what exactly are the disclosed AMPS derivatives

***Response to Arguments***

5. Applicant's arguments filed 10/10/08 have been fully considered but they are not persuasive.

Applicant says amendment to claim 8 reciting 2-acrylamido-2-methyl-propane sulfonic acid (AMPS) overcomes the rejection. The amendment does overcome the present rejections because the meets and bound of derivatives of AMPS is not clear. The examiner has gleaned through the specification and the specification does not provide compounds that are derivatives of AMPS. Thus, boundaries of the derivatives of AMPS have not been described and the specification does not also provide guidance for what those derivatives are using the specification as a dictionary.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 8-13, 23, 25-35 and 37-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubief et al. (US 6,090,376).

8. Dubief discloses composition comprising at least one grafted silicone polymer in particle form dispersed in aqueous medium, amphiphilic polymer (abstract; column 1, lines 32-43;

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column 2, lines 21-27; column 5, lines 28-30; column 7, lines 5-7), water (column 6, line 64), vegetable, animal or synthetic oils or vitamins or surfactants (column 7, lines 8-13). The composition comprising the amphiphilic polymer, the grafted silicone polymer meeting the limitation of tensioning polymer of claim 1, water and oil meets claims 1 and 33. The amphiphilic polymer is used in amounts of between 0.01 to 20 wt% (column 6, lines 59-62) and the amphiphilic polymer can be based on acrylic polymers (column 5, line 60 to column 6, line 56) with the acrylic polymers meeting claim 8-13. Exhibiting “a retraction of isolated stratum corneum ... in water is a property/characteristic of the tensioning polymer and the tensioning polymer of Dubief would have the same property/characteristic. Claim 1 requires that the surfactant be present at amounts of less than 1% by weight relative to the total composition and the suggestion by Dubief that the additive surfactant be present at amounts of 0-20, with the lower limit of 0 being less than 1% suggestive that an amount of less than 1% can be used so that that limitation brought from original claim 24 into claim 1 is met. The requirement that the surfactant be different from the amphiphilic polymer is also met because, Dubief discloses composition containing amphiphilic polymer, surfactant.

Claims 11, 12 and 23, 25-32 recite the amounts of the acrylic polymer/ionic amphiphilic polymer, tensioning polymer, fatty phase, surfactant and water. Dubief does not teach the exact amounts recited in those claims. The amount of the ionic amphiphilic polymer of Dubief at 0.01 to 20 wt% (column 6, lines 59-62) encompasses the claimed amount of the ionic amphiphilic polymer or acrylic polymer. While Dubief suggests the use of additive surfactant polymer at 0-20%, Dubief does not specifically relate the amount of the surfactant to the total weight of the composition, and while these amounts are not exactly the same as those recited in the claims, the

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amounts recited in the claims would have been obvious because the person of ordinary skill in the art would have good reason to use various components of the composition in amounts that would provide composition that when applied to hair would effectively treat the hair as regards entangling/disentangling and smoothness and styling and feel. In the absence of unexpected results, the amounts recited in those claims are not inventive over the teaching of Dubief.

***Response to Arguments***

9. Applicant's arguments filed 10/10/08 have been fully considered but they are not persuasive.

10. Applicant argues that the silicone in Dubief does not have silicone in the skeleton because the skeleton in Dubief non-silicone and that to arrive at the present invention one would have to destroy the operability of the Dubief composition. The examiner disagrees because claim 1 as amended requires a "grafted silicone having a main silicone chain" and the grafted silicon though having a non-silicone skeleton has silicone in the main chain and thus meets the claims noting that the claim does not say that the skeleton of the grafted polymer is silicone. Therefore, no destruction of the composition of Dubief is necessary because modification is only required for the amounts the surfactant.

11. Applicant further argues that Example 1, table 1 provides unexpected results when using none or less than 1% surfactant in the claimed composition. This is not found persuasive, because Example 1 is specific composition and claim 1 does not recite a specific composition in which all the components are defined as to amounts and the specific components.

12. Claims 1, 8-13, 23, 25-35 and 37-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubief et al. (US 6, 090,376) in view of Nandagiri et al. (US 5,362,486).

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13. Claim 1 has been described above as obvious over Dubief using grafted silicone polymer. Dubief discloses composition comprising ionic amphiphilic polymer, tensioning polymer, water and oil as described above. The composition of Dubief is applied to the hair for treatment (abstract). The tensioning polymer of Dubief is a grafted silicone interpenetrating polymer as stated above. Dubief does not teach polyurethane and polyacrylic as tensioning polymer as recited in amended claim 1 as one of the choices for the polymer. However, Nandagiri discloses composition comprising polyurethane-acrylate for bodifying hair (column 15, lines 13-62). Therefore, taking the two references together, it would have been obvious to use the polyurethane-acrylate tensioning interpenetrating polymer of Nandagiri in the composition of Dubief and expect to have a composition for treating hair as it relates to body, feel, styling and disentangling of the hair.

#### ***Response to Arguments***

14. Applicant's arguments filed 10/10/08 have been fully considered but they are not persuasive.

15. Applicant traverses this rejection as lacking motivation to substitute the polymer of Nandagiri for the grafted silicone polymer because applicant contends that such a substitution would destroy the composition of Dubief. The examiner disagrees. Since the composition of Nandagiri is for bodifying hair, one having ordinary skill in the art would have reasonable expectation that using the polyurethane-acrylate tensioning polymer in place of the grafted silicone would naturally produce composition that is expected to treat/bodify hair. Hence Nandagiri is relied upon for teaching polyurethane-acrylate tensioning polymer even if the polymerization takes place in situ; the end result is a composition for hair care. The term

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tensioning polymer does not have to be explicitly disclosed. In this case, the term “tensioning” is a functional language describing the polymers and both prior art references teach/disclose polymers that meet the polymer that have the “tensioning” function.

16. Claims 1 and 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubief et al. (US 6, 090,376) in view of Daiko et al. (US 6,846,812).

Dubief uses composition containing grafted silicone to treat hair or keratinous substances (abstract) as described above. Dubief does not teach using the composition containing grafted silicone to treating/smoothing wrinkled skin or restoring skin tautness. But composition containing grafted silicone is known to have the capability of fading out irregularities if the skin such as wrinkles and fine lines according to Daiko (column 6, lines 3, 4, 14 and 27; column 10, lines 60-62; column 11, lines 29-45; column 12, lines 50-53). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the composition of Dubief to the skin and expect the composition to smooth wrinkled skin as taught by Daiko.

#### ***Response to Arguments***

17. Applicant's arguments filed 10/10/08 have been fully considered but they are not persuasive.

18. Applicant's argues that there is no motivation to combine Dubief with Daiko to arrive at the claimed invention. The examiner disagrees because composition containing the same polymer as Dubief is known according to Daiko for treating/smoothing wrinkled skin or restoring skin tautness and there is thus reasonable expectation of success that compositions such



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as that described by Dubief containing grafted silicone would be effective for treating/smoothening wrinkled skin or restoring skin tautness.

### ***Double Patenting***

19. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

20. Claims 1, 2, 6-13 and 23, 25-25 and 37-46 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-35; and 1-16 and 19-21 of copending Application Nos. 10982925 and 10/508007 respectively for reasons of record and reiterated herein. Although the conflicting claims are not identical, they are not patentably distinct from each other because the examined claims and the co-pending claims are concerned with compositions containing amphiphilic polymer, tensioning polymer, aqueous phase and oil phase for treating keratinous substances and for treating skin conditions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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21. Claims 1, 2, 6-13 and 23, 25-35 and 37-46 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 60-116 and 1-59 of copending Application Nos. 10/591,583 and 10/573,579 respectively for reasons of record and reiterated herein for reasons of record and reiterated herein. Although the conflicting claims are not identical, they are not patentably distinct from each other because the acrylates of the 10/591,583 and 10/573,579 applications are homologs of the acrylates of the examined claims; with the compositions of pending claims containing tensioning polymers, oil, water and surfactant for treating or softening wrinkled skin.

22. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Response to Arguments***

23. Applicant's arguments filed 10/10/08 have been fully considered but they are not persuasive.

24. Applicant is of the opinion that because the arguments have overcome the art rejections and would appear that the provisional obviousness-type double patenting rejection is the only rejection left, and as such the claims being allowable would be allowed to go to issue upon withdrawal of the rejections. But, the provisional obviousness type double patenting rejection is not the only rejection. Since the provisional obviousness type double patenting rejection is not the only rejection in the examined application and the rejection will continue to be made until the rejection is overcome as stated in MPEP 804 [R-5], I B, that "the "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double

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patenting rejection is the only rejection remaining in at least one of the applications." As noted above, the provisional obviousness double patenting rejection is not the only rejection remaining in this examined application. Thus rejection is maintained and is not held in abeyance.

25. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BLESSING M. FUBARA whose telephone number is (571)272-0594. The examiner can normally be reached on 7 a.m. to 5:30 p.m. (Monday to Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Blessing M. Fubara/  
Examiner, Art Unit 1618